

REMARKS

The Restriction Between Groups IV-VI Should be Withdrawn

As stated previously, Applicant herein elects to prosecute the invention of Group VI, original claims 5-18, with traverse. Specifically, Applicant traverses the restriction requirement of Groups IV-VI because the subject matter of the required search is sufficiently small and closely related as to be capable of examination together. The search would not be an undue burden on the Office.

The Office action restricts the claims to a single sequence per claim based on the assertion that the sequences set forth in SEQ ID NOS: 14, 16 and 18 are different molecules with different chemical and physical structures. As such, the Office action asserts SEQ ID NOS: 14, 16, and 18 would require separate searches, which would be burdensome on the Office.

Applicant respectfully disagrees and requests examination of SEQ ID NOS: 14, 16, and 18 together in original claims 5-18 (i.e., Applicant requests concurrent examination of the inventions of Groups IV-VI) because the inventions of Groups IV-VI are related inventions and examination of all claims comprising these groups would not constitute a burden to the Patent Office. Specifically, the claims of Group IV-VI are directed to nucleic acid molecules comprising a nucleotide sequence having at least 85% sequence identity to SEQ ID NOS: 14, 16, or 18, respectively, vectors, cells comprising said nucleic acid molecules, and a method of making a polypeptide following expression of said isolated nucleic acid molecules. The Office will not be burdened by examining the inventions set forth in SEQ ID NOS: 14, 16, and 18 together because of the shared structure and functional characteristics of SEQ ID NOS: 14, 16, and 18. Indeed, shared structural features will simplify the Office's search. According to the attached BLAST reports, SEQ ID NOS: 14 and 18 share 92% overall sequence identity; SEQ ID NOS: 14 and 16 share 96% overall sequence identity; and SEQ ID NOS: 16 and 18 share 96% overall sequence identity. See results of BLAST search result at Tab A. Moreover, as outlined in the specification, SEQ ID NOS: 14, 16, and 18 share 100% sequence identity at the nucleotide level in the A1_P, C1_H, and C2_H domains of the nucleotide sequence encoding factor VIII polypeptide. See table I, page 7 of the specification. Thus,

there is significant shared structural similarity between SEQ ID NOS: 14, 16, and 18. Further, shared functional characteristics also will simplify the Office's search. Each of SEQ ID NOS: 14, 16, and 18 encodes a factor VIII polypeptide that is characterized by "high-level expression." Applicant notes that all claims recite this functional feature. Accordingly, contrary to the Office's conclusions, Groups IV, V, and VI do share common physical and chemical structures that will expedite the Office's search.

In addition to the relative ease of searching SEQ ID NOS: 14, 16, and 18 together given their structural and functional similarities, Applicant respectfully requests that the Office also consider the application under MPEP 803.04, which states "up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction." The sequences involved in this case, although patentably distinct, have high sequence identity. As discussed above, their sequence identity reduces the search burden on the Office as a search for one would very likely be coextensive with and return the same search results as the other sequences. Applicant's position is supported by the fact that the search conducted by the EPO on each separate sequence of the corresponding EP application returned identical search results. See Tab B, Supplementary Partial European Search Report (May 25, 2006) and Supplementary European Search Report (July 27, 2006). In this case, shifting the burden to the Applicant to file additional patent applications would put an unreasonable financial burden on the Applicant and a physical burden on the Patent Office to examine in three applications what could clearly and easily be examined in one.

In summary, Groups IV, V and VI are drawn to SEQ ID NOS: 14, 16, and 18 and share common utility, functional characteristics, and chemical and physical structures. The requirements of MPEP 803.02 have been satisfied and the restriction requirement between Groups IV, V, and VI should be withdrawn.

SUMMARY

Applicant respectfully submits that the present application is now in condition for allowance, and respectfully requests same. If, for any reason, the Office feels a discussion would expedite the prosecution of this application, the Office is kindly invited to contact the undersigned at (312) 245-5319.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "C. Noel Kaman", is written over a horizontal line.

C. Noel Kaman

Registration No. 51,857

Attorney for Applicant

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200